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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/286,739	04/06/1999	HUGH E. MCLOONE	M61.12-0124	5377

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EXAMINER

WU, XIAO MIN

ART UNIT	PAPER NUMBER
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2674

DATE MAILED: 04/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/286,739	Applicant(s) MCLOONE ET AL.	
	Examiner XIAO M. WU	Art Unit 2674	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,5-12,14,16-18 and 25-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,5-12,14,16-18 and 25-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. In view of the Appeal Brief filed on 1/7/2005, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below:

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the

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reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 7, 10, 11 are rejected under 35 U.S.C. 102(e) as being anticipated by Schena et al. (US Patent No. 6,166,723).

As to claim 7, Schena discloses a mouse (Fig. 1a) for a computer system, the mouse comprising: a thumb gripping position located on a side of the mouse (see Fig. 1a) ; a primary button (15) positioned so as to capable of being actuated by a user's index finger when the user's thumb is located on the thumb gripping position; and at least one side button (15a) positioned so that a gap between the user's thumb and the user's index finger is reduced when the user's thumb is moved from the gripping position to actuate the side button while the user's index remains fixed on the primary button (e.g. the side button 15a is located between the primary mouse button 15 and the gripping portion), wherein the thumb gripping position comprises a surface that is substantially level with a surface of the at least one side button along a boundary between the gripping position and the at least one side button (see Fig. 1a).

As to claim 10, Schena discloses the user's thumb registers with a working surface over which the mouse moves when the user's thumb is located at the thumb gripping position (see Fig. 1a).

As to claim 11, Schena discloses a space exists between the user's thumb and the at least one side button when the user's thumb is located at the thumb gripping position (see Fig. 1a).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1, 3, 5-6, 8-9, 14, 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schena et al. (US Patent No. 6,166,723) in view of Gordon et al. (US Patent No. 6,281,882).

As to claims 1, 3, 6, 8-9, Schena discloses a mouse input device for a computer system, the mouse capable of being moved across a working surface to move display object on a computer display, the mouse comprising: an upper casing; a bottom surface designed to face the working surface (see Fig. 1a); a thumb pinching area located on a side of the side of the mouse proximate the bottom surface (see Fig. 1a); a primary button (15, right button); a secondary button (15, left button); and one side button (15a) located above the thumb pinching area in a direction away from the bottom surface. It is noted that Schena does not specifically disclose

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two side buttons. However, a mouse including two symmetrical side buttons is well known in the art such as taught by Gordon (see col. 9, lines 26-33). It would have been obvious to one of ordinary skill in the art to have modified Schena with another symmetrical side button as suggested by Gordon so that the user's right ring index can input additional mouse function.

As to claim 5, Schena discloses a user's thumb avoids contacting the at side button when the user's thumb rests in the thumb pinch area (see Fig 1a).

As to claims 14, 17, 18, Schena discloses a mouse for a computer system, the mouse capable of conveying signals to the computer indicative of movement of the mouse across a working surface, the mouse comprising: a metacarpophalangeal ridge support (col. 4, lines 62-65); a secondary button (e.g. left mouse button 15); Schena as modified by Gordon would provide a ring finger and little finger convex support slope that is separate from the secondary button, each surface point of the support slope having a normal that at least partially points away from the working surface (see Fig. 1a of Schena, and col. 9, lines 26-32).

As to claim 16, Gordon discloses the secondary button freely moves when actuated by the user's middle finger (col. 9, lines 33-36).

7. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schena et al. (US Patent No. 6,166,723) in view of Gordon et al. (US Patent No. 6,281,882) as applied to claim 8 above, and further in view of Adan et al. (US 2002/0054023).

As to claim 12, it is noted that both Schena and Gordon do not disclose the side button comprising a forward button and a rear button and a majority of the forward button being closer to the front of the mouse than a majority of the rear button. Adan is cited to teach a side button (200) comprising a forward button (2280, Fig. 2B, 2C) a rear button (230, Fig. 2B, 2C) and a

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majority of the forward button (228) being closer to the front of the mouse than a majority of the rear button (230). It would have been obvious to one of ordinary skill in the art to have modified Schena as modified with the features of the forward/backward buttons as taught by Ada n so as to provide a convenient way to navigate the Internet.

8. Claims 25-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stephens et al. (US Patent No. 6,417,843).

As to claims 25, 26, Stephens discloses a mouse for a computer comprising: a bottom surface designed to face a working surface over which the mouse is moved; an upper housing; and a wheel, located in the upper housing and comprising ribs along its outer surface (27, Fig. 6). It is noted that Stephens does not specifically disclose at least fifty ribs along its outer surface. However, the number of the ribs is considered as an obvious design choice since it does not solve any stated problem or have any unexpected results.

As to claim 27, Stephens discloses the ribs are evenly spaced across the wheel surface (see Fig. 6).

As to claims 28-31, the rib's shapes and exact size are considered as an obvious design choice because it depends on the what size of the mouse and what size of the wheel are desired.

Allowable Subject Matter

9. Claim 12 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The US Patent 5,530,455 is cited to teach a mouse including a side button..


11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to XIAO M. WU whose telephone number is 571 272-7761. The examiner can normally be reached on 6:30 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, PATRICK EDOUARD, can be reached on 571 272-7603. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

x.w.

April 17, 2005


XIAO M. WU
Primary Examiner
Art Unit 2674